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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,439	09/05/2003	Diana K. Smetters	D/A3162	8476
35699	7590	05/16/2007		
PARC c/o PARK, VAUGHAN & FLEMING LLP 2820 FIFTH STREET DAVIS, CA 95618-7759			EXAMINER LEMMMA, SAMSON B	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,439	Applicant(s) SMETTERS ET AL.	
	Examiner Samson B. Lemma	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13, 15-22 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 15-22 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The request filed April 30, 2007 for a request for continued examination (RCE) under 37 CFR 1.114 based on patent application 10/656,439 is acceptable and an RCE has been established. Every Independent **claims 1, 10 and 19** has been amended. Claims 5, 14 and 23 have been previously canceled. New claims 29-30 are added.

Response to Arguments

2. Applicant's remark/arguments filed on April 30, 2007 have been fully considered but they are not persuasive.

Applicant argument is based on the limitation added to the respective independent claims, namely **"wherein the preferred channel does not require being resistant to evesdropping."**

It is found that such negative is not supported by the specification/original disclosure. [Paragraph 0057 and 0078] of the applicant's specification had been considered however no support for such amendment was found.

Note: What has been described on the applicant's publication no. 20040268119, paragraph 0055 as follows "The authenticity property of the preferred channel means that it is impossible or difficult for an attacker to transmit over the preferred channel or tamper with messages sent over the preferred channel without detection by the legitimate parties to the communication" is different from the limitation recited as **"wherein the preferred channel does not require being resistant to evesdropping."**

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Independent Claims 1, 10 and 19** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification/original disclosure fails to mention/specify or teach the following negative limitation, is added in every independent claims 1,10 and 19, **"wherein the preferred channel does not require being resistant to eavesdropping."**

Thus the above negative limitation is considered/found to be a new matter.

5. Regarding the present amendment made to the independent claims 1, 10 and 19, where claims are amended to include the limitation **"wherein the preferred channel does not require being resistant to eavesdropping..."**, the examiner cites the proper **MPEP 2173.05 (i)** in support of the 112 rejection set forth in this office action.

"Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement."

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The amended phrase clearly recites a negative limitation. Indeed, the specification/disclosure must contain a full, clear and concise description of the claimed subject matter. The specification does not literally or implicitly exclude **the preferred channel from being resistant to eavesdropping.**

For the purpose of examination, the office has fully considered/examined all the rest of the limitations, except the negative limitation indicated above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1-4, 6-13, 15-22 and 24-30** are rejected under 35 U.S.C. 102(b) as being anticipated by **Hermann, Reto** (hereinafter refereed as **Hermann**) (European Patent Publication No. EP1024626A1) (Publication Date 08/02/2000) (Submitted with the Applicant's IDS)

8. **As per independent claims 1, 10 and 19** Hermann discloses a computer controlled method comprising:

- **Establishing communication between a situation notification device** [see , paragraph 0020, "first device"] **and a provisioning device** [see , paragraph 0020, "second device/servicing device"] **over a preferred channel** [See, paragraph 0020, "communication link"];[paragraph 0020, lines 15-21]
- **Providing provisioning information to said situation notification device over said preferred channel,[Paragraph 0020, lines 44-48]** *(After receiving the sequence, the serving device responds by sending back over a wireless broadcast*

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medium a respond. And as it is disclosed on paragraph 0020, lines 44-48 such responds may comprises, a key, also a session key and a communication parameters which meets the limitation of provisioning information from serving device to personal device/ situation notification for further communication. In other words the personal device/ situation notification device is provided with key, session key and a communication parameters/provisioning information)

wherein said situation notification device is automatically configured to receive subject matter information responsive to said provisioning information;

[Paragraph 0020, lines 48-49] (And the situation notification device is automatically configured to receive the encrypted information which meets the limitation of the subject matter information)

- **Receiving said subject matter information;** [Paragraph 0020, lines 48-49]
(encrypted information)
- **Verifying said subject matter information with said provisioning information;** [Paragraph 0014] *(Only the intended receiver/ notification device receives the encrypted subject matter since it is the one that has the corresponding decryption key and the encrypted information/ subject matter information with the corresponding private key/ public key/ session key/ provisioning information are decrypted and verified that the subject matter is sent form the right provisioning device.)*
- **Presenting said subject matter information to a user of the situation notification device responsive to the step of verifying, wherein the step of verifying ensures that the subject matter information is genuine..**
[Paragraph 0014 & abstract] (Only the intended receiver/ notification device receives the encrypted subject matter since it is the one that has the corresponding

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decryption key. And the encrypted information/ subject matter information is presented to a user of the situation notification device only and only if the situation notification device carries the corresponding private key/public key/ session key/provisioning information and successfully decrypts and verifies that the subject matter is sent from the right provisioning device, by doing so the situation notification device ensures that the subject matter information is genuine. This is simply another application of public key cryptography, explained on paragraph 0014 and secure transmission disclosed in the abstract.)

9. As per claims 2, 11 and 20 Hermann discloses a computer controlled method as applied to claims above. Furthermore, Hermann discloses a method, wherein the step of providing further comprises:

exchanging key commitment information over said preferred channel between said provisioning device and said situation notification device; [paragraph 0020]

receiving a public key by said situation notification device; [paragraph 0021, line 39] verifying said public key with said key commitment information [Paragraph 0021, lines 41-42] [the serving device, inherently verifies the password or the public key sent by the personal device before responding to the personal device. After verification, the service device sends back a communication parameters for further communication to the personal device]; and receiving a credential authorized by a credential issuing authority. [paragraph 0022]

10. As per claims 3, 12 and 21 Hermann discloses a computer controlled method as applied to claims above. Furthermore, Hermann discloses a method, wherein said preferred channel is a location-limited channel. [paragraph 0020, lines 20-21]

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11. **As per claims 4, 13 and 22** Hermann discloses a computer controlled method as applied to claims above. Furthermore, Hermann discloses a method, wherein, wherein said preferred channel uses a telephone switching system. [paragraph 0025-0026 and 0041-0042]
12. **As per claims 6, 15 and 24** Hermann discloses a computer controlled method as applied to claims above. Furthermore, Hermann discloses a method, wherein subject matter information is received using an antenna, a telephone line, a local area network, a wide area network, a wireless network, or a broadcast network. [paragraph 0041-0042]
13. **As per claims 7, 16 and 25** Hermann discloses a computer controlled method as applied to claims above. Furthermore, Hermann discloses a method, wherein said situation notification device is a computer, a television, a radio, a telephone, a push to talk device, a pager, a clock, a thermostat, a network appliance, or a home appliance. [paragraph 0039]
14. **As per claims 8-9, 17-18 and 26-27** Hermann discloses a computer controlled method as applied to claims above. Furthermore, Hermann discloses a method, further comprising forwarding said subject matter information, wherein said subject matter information is alarm information. [Paragraph 0039, lines 44-46]
15. **As per claims 29-30** Hermann discloses a computer controlled method as applied to claims above. Furthermore, Hermann discloses a method, wherein said preferred channel has a demonstrative identification property and an authenticity property. [paragraph 0027] *(The limitation recited in the amended independent claims as the preferred channel has "demonstrative identification property" is defined as follows in applicant's specification, (see publication no. 20040268119, paragraph 0054, the last sentence), "The demonstrative identification property of the preferred channel means that human operators are aware of which devices are communicating with each other over the*

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preferred channel and that the human operators can easily detect when an attack is being made on the preferred channel."

Furthermore, the limitation recited in the amended independent claims as the preferred channel has "an authenticity property" is defined as follows in applicant's specification, (see publication no. 20040268119, paragraph 0055)

"The authenticity property of the preferred channel means that it is impossible or difficult for an attacker to transmit over the preferred channel or tamper with messages sent over the preferred channel without detection by the legitimate parties to the communication."

Examiner would like to point out that the reference on the record, namely Hermann discloses such concepts/limitation as shown below which meets the recitation the amended limitation.

Hermann on paragraph 0026 discloses that initiating the communication session and for transmitting an initial-sequence that may contain sensitive information, the unidirectional wireless communication channel can ensure that only the target device receives the initial-sequence. It is especially advantageous if a directed channel as line-of-sight link can be used, because then no other parties can eavesdrop and receive the initial-sequence. Such a channel can be an optical channel, e.g. an infrared or a laser channel, a Personal Area Network (PAN) channel, a directed radio-frequency (RF) channel, an inductive channel, a capacitive channel, or every other channel that is suitable for low-range, directed communication links.

Furthermore Hermann on paragraph 0029, discloses that it is very simple to set up a communication if the personal device is connected to a user, e.g. by a PAN, because the user touches then in an intuitive way the serving device for initiating the unidirectional wireless communication channel via his body. There are no additional cards or other things necessary for setting up an authenticated session.

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The above paragraphs such as paragraph 0026 & 0029 recited on the record implies the fact that "when attack is being made on the preferred channel it can easily detected"and meets the limitation recited as " the preferred channel has "demonstrative identification property"

Likewise, Hermann on paragraph 0030, discloses that if the response as well as the further communication over the wireless broadcast medium is protected by using a cryptosystem, than the advantage occurs, that the exchanged information is hidden perfectly and can not be uncovered by someone else. A suitable system can be a public-key cryptosystem where only the public key is exchanged once. Furthermore, what is recited on paragraph 0026 in combination with the "authenticated session" or "protected by using a cryptosystem" disclosed on paragraph 0026 and 0029, meets the limitation that "the preferred channel has "an authenticity property")

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samson B Lemma whose telephone number is 571-272-3806. The examiner can normally be reached on Monday-Friday (8:00 am---4: 30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BARRON JR GILBERTO can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-873-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAMSON LEMMA

S.L.
05/12/2007



Benjamin E. Lerner
Examiner AU 2132